

October 7, 2003
Case No.: DP-306837 (7500/141)

Serial No.. 10/092,320

Filed: March 6, 2002

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- REMARKS -

The rejection of claims 1-18 as unpatentable over Yamamoto in view of Hein under 103(a) is traversed. For this 103(a) rejection to stand, each and every element of the claimed invention must be taught or suggested by the references themselves, and there must be some motivation or suggestion to combine the references, *in the references themselves*, to arrive at the claimed invention.

There is no suggestion in Yamamoto in view of Hein to modify in this fashion, and there is no motivation provided. In order to prove a prima facie case of obviousness, the Examiner is required to provide affirmative evidence to support such a position. As the Examiner is well aware, the motivation to modify or combine must come from the references themselves. See MPEP 2143.01. A conclusory allegation that "[I]t would have been obvious to one of ordinary skill in the art to have spaced apart the periphery of the decoupler of Yamamoto et al in view of the teaching of Hein et al so as to allow for different degrees of damping for different oscillations as taught by Hein et al." entirely fails to meet the Examiner's evidentiary burden to prove a prima facie case. The motivation to combine or modify *cannot* come from the Examiner, without the taking of official notice, or preparation of an Examiner's affidavit. Without some evidence of a motivation to combine, this rejection cannot stand.

Furthermore, the mere fact that the references could be combined to arrive at the claimed invention (which Applicants do not concede) is insufficient to prove a prima facie case. See MPEP 2143.01, In Re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990) and In Re Fritch, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). While applicants do not agree that the combination of the references would result in the claimed invention, there must be some motivation or suggestion in the references to combine to support a prima facie case of obviousness. In the absence of any such motivation or suggestion, the rejection must fail.

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Additionally, as described in the Graham case, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. See Graham v. John Deere Co., 383 U.S. 1 (1965). In this case, the Examiner appears to have engaged in impermissible hindsight, as there is a void of evidence around the Examiner's allegation of obviousness. In view of the fact that the Examiner was entirely unable to support the allegation of obviousness with a citation to either Yamamoto or Hein, the Examiner's use of impermissible hindsight is apparent.

The 103(a) rejection to claims 1-18 must fall as the references do not teach or suggest each and every element of the claimed invention, and there is no motivation or suggestion to combine in the prior art. Additionally, the Examiner appears to have engaged in impermissible hindsight

Specifically, the references do not teach or suggest, alone or in combination, that the periphery of the diaphragm is spaced apart from at least one of the upper or lower orifice plates, as claimed in claims 1, 8, and 14. Claims 2-7, 9-13 and 15-18 depend from claims 1, 8 and 14 respectively, and are allowable over Yamamoto in view of Hein for at least the same reasons.

Withdrawal of the rejections of claims 1-18 is requested.

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CONCLUSION

The Applicants respectfully submit that claims 1-18 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated. October 7, 2003

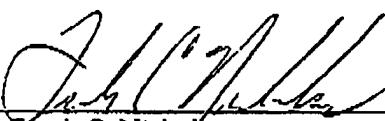
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